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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,876	03/03/2004	Jordan L. Kimball	23672.00	4730
37833 7590 01/08/2007 LITMAN LAW OFFICES, LTD PO BOX 15035 CRYSTAL CITY STATION ARLINGTON, VA 22215			EXAMINER ZURITA, JAMES H	
			ART UNIT	PAPER NUMBER
			3625	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/08/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/790,876

Applicant(s)

KIMBALL, JORDAN L.

Examiner

James H. Zurita

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Prosecution History

On 3 March 2004, applicant filed the instant application.

On 22 September 2005, the application was published as 20050210149.

Claim Objections

Claims 1, 2, 7, 8, 14 and 15 refer to "...predetermined...", a relative term.

Claims 1, 7, and 14 contain two terms joined with a forward slash "...secondary level domain *name/inclusive* name space (SLD name)..." that renders the terms indefinite. The terms will be interpreted as synonyms.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2, 6-8, 13-15, 18-20 are rejected under 35 U.S.C.102(e) as being anticipated by Schneider (US 6760746), filed 1 August 2000, published 6 July 2004.

As per claim 1, Schneider discloses method(s) to facilitate name preservation across an unrestricted set of Top Level Domains (TLDs), said method comprising:

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- executing TOP LEVEL DOMAIN TOPOLOGY (TLDT) software in a TLDT system (see, for example, at least Col. 19, lines 17-38);
- choosing to register a predetermined secondary level domain name/inclusive name space (SLD name) for a particular TLD (see, for example, at least Col. 32, line 50-Col. 33, line 3; see also Fig. 10C and related text));
- retrieving data for a desired secondary level domain name to register the SLD name in association with at least one TLD in at least one of a Public Root and an Internet Corporation for assigned Names and Numbers (ICANN) Root (see, for example, at least Col. 3, lines 37-47; see also Col. 4, line 66-Col. 5, line 25);
- conducting a search of at least one of a Public Root and an ICANN Root and determining whether the desired SLD is associated with any TLDs that exist in the ICANN root system and the TLDT system (see, for example, at least Col. 6, lines 9-22; see also Col. 32, lines 50-65);
- reporting any TLDs that are associated with the desired SLD, and any available TLDs that are not associated with the desired SLD (see, for example, at least Fig. 9b and related text);
- determining whether payment of a periodic fee will be made to register the desired SLD with all TLDs that are not associated with the desired SLD (see, for example, at least Fig. 10d and references to registration fee); and
- registering the desired SLD with all TLDs that are not associated with the desired TLD payment if the periodic fee will be made (see, for example, claim 20, see also Fig. 10c and related text):

As per claim 2, Schreiber discloses that conducting a search of at least one of a Public Root and an ICANN Root step further comprises designating a cluster of TLD key word directories associated with predetermined TLD databases (see, for example, at least Fig. 10c and related text; see also Col. 21, line 57-Col. 22, line 16).

As per claim 6, Schneider discloses registering the desired SLD with all TLDs that are not associated with the desired SLD (see, for example, at least Fig. 10c, and related text).

As per claim 11, Schneider discloses utilizing LINK cells representing particular web pages (see, for example, discussion of relations between name space and links, as in Col. 10, line 21-50).

Claim 7 is rejected on the same grounds as claim 1.

Claim 8 is rejected on the same grounds as claim 2.

Claim 13 is rejected on the same grounds as claim 6.

Claim 14 is rejected on the same grounds as claim 1.

Claim 15 is rejected on the same grounds as claim 2.

Claim 18 is rejected on the same grounds as claim 11.

Claim 19 is rejected on the same grounds as claim 5.

Claim 20 is rejected on the same grounds as claim 6.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-5, 9-12 and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schneider, above.

As per claims 3 and 4, Schneider does not use the term percentage.

Schneider refers to probability (as in Col. 8, lines 36-63). It would have been obvious to one of ordinary skill in the art at the time the invention was made to:

(claim 3) determine a percentage chance of success in searching a particular TLD (see, for example, references to probability, as in Col. 8, lines 36-63).

(claim 4) report the percentage chance of success in searching a particular TLD.

One of ordinary skill in the art at the time the invention was made would have been motivated to extend Schneider to express probability as a mathematical estimate such as percent, and

(claim 3) determine a percentage chance of success in searching a particular TLD (see, for example, references to probability, as in Col. 8, lines 36-63).

(claim 4) report the percentage chance of success in searching a particular TLD for the obvious reason that probability is often estimated mathematically.

As per claim 5, Schneider does not specifically disclose presenting a check box to a user to indicate that TLDT system administration will pay for SLDs available from the ICANN root system for associated TLDs. Schneider discloses payment of fees for registering (Fig. 10d and related text, for example). Schneider also discloses

checkboxes, as in Figs. 5 and 10c. Schneider also discusses the use of brokers (applicant's system administrator), as in Col. 28, line 54-Col. 28, line 4).

It would have been obvious to one of ordinary skill at the time the invention was made to extend Schneider to disclose presenting a check box to a user to indicate that TLDT system administration will pay for SLDs available from the ICANN root system for associated TLDs.

One of ordinary skill at the time the invention was made would have been motivated to extend Schneider to disclose presenting a check box to a user to indicate that TLDT system administration will pay for SLDs available from the ICANN root system for associated TLDs for the obvious reason of facilitating payment between a registrant and the various register authorities.

Claim 9 is rejected on the same grounds as claim 3.

Claim 10 is rejected on the same grounds as claim 4.

Claim 12 is rejected on the same grounds as claim 5.

Claim 16 is rejected on the same grounds as claim 3.

Claim 17 is rejected on the same grounds as claim 4.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H. Zurita whose telephone number is 571-272-6766. The examiner can normally be reached on 8a-5pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

James Zurita
Primary Examiner
Art Unit 3625
3 January 2006

James Zurita
Primary Patent Examiner